

**REMARKS**

**I. Amendments and Status of the Claims**

Claims 1-17 are pending, with claims 1, 10, 11, and 13-17 being independent, and claims 14-16 being withdrawn from consideration. "Claims 10 and 13 are characterized as allowable." Office Action at page 2.

Claims 1, 4, 6-8, 11, 12, and 17 have been amended without prejudice to pursue canceled subject matter, if any, in a continuing application, and without disclaimer of any subject matter.

Following some of the Examiner's suggestions, Applicants have amended claims 1 and 17 to more particularly point out and distinctly claim the subject matter Applicants regard as their invention. For example, claims 1 and 17 now recite that the catalytic hydrogenation occurs on the olefinic group, and that the compound of formula III (claim 1) or formula III' (claim 17) or its salt is obtained. Support for these amendments can be found throughout the application and claims as originally filed.

Claim 17 and page 8 of the specification have been amended to correct the structure of formula I'. Specifically, two amine groups now appear in the chain comprising A, B, and G. This amendment represents the correction of an obvious error, and does not represent the introduction of new matter into the application. See M.P.E.P. § 2163.07(II) (*citing In re Oda*, 443 F.2d 1200, 170 U.S.P.Q. 268 (C.C.P.A. 1971)). The process for preparing a compound of formula I' appearing on pages 8-11 show starting materials and intermediates that have the missing nitrogen atoms; those same nitrogen-containing compounds appear in claim 17 itself. Regarding the amine group between B and G, the skilled artisan would recognize that the reaction between the compound of formula III' and the compound of formula IV' would not occur unless

the nitrogen is present. Moreover, the reaction would yield a compound still containing that nitrogen. Accordingly, the skilled artisan reading the specification and claim 17 would recognize the existence of an error, and would also recognize the appropriate correction. Therefore, this amendment does not represent the introduction of new matter. See M.P.E.P. § 2163.07(II).

Minor clarifying amendments have been made to claims 1, 4, 6-8, 11-12, and 17. In claims 1, 11, and 17, "give" has been changed to "yield," to use the same word throughout the claims. See *e.g.*, claim 5. In claim 4, Applicants have changed "is" to "comprises," to avoid an unnecessarily narrow construction of the claim. Amendments to claims 6-8 clarify the antecedent bases found in claim 1. In claims 8 and 12, "as such" now reads "in free form." Applicants intended that the compound used "as such" would be present in free form, as evidenced in the specification at page 19, line 19, for example.

## **II. Acknowledgement of Priority Document**

Applicants respectfully request that the Examiner acknowledge the submission of the priority document. Applicants filed a certified copy of German Patent Application DE 100 03 586.8 on January 26, 2001, but have received no indication that their claim for priority has been acknowledged.

## **III. Restriction Requirement**

Applicants thank the Examiner for rejoining, examining, and allowing claims 10 and 13. See Office Action at page 2. Applicants respectfully maintain their traverse of record (see Response to Restriction and Election Requirements filed on February 21, 2003), and request that claims 14-16 be rejoined and examined with the pending

claims. Rejoining and examining claims 14 and 15, at least, should not prove to be unduly burdensome, given the similarity of the subject matter of those claims to the subject matter of examined claims. See M.P.E.P. § 803.

#### **IV. Claim Rejections Under 35 U.S.C. § 112**

Claims 1-9, 11, 12, and 17 have been rejected under 35 U.S.C. § 112, ¶ 2, as indefinite for allegedly failing to particularly point out and distinctly claim the subject matter Applicants regard as their invention. Office Action at page 2. Claim 1, for example, is allegedly indefinite (a) as to the means by which the compound of formula II is converted into the compound of formula III; and (b) for failing to recite a step for isolating the final product. *Id.* Moreover, “[t]he same issues apply in claim 17 as in claim 1.” *Id.* at page 3. Finally, claim 11 is allegedly “rendered indefinite by its failure to recite a step for isolation of the final product.” Applicants respectfully traverse this rejection.

Applicants respectfully assert that their claims were definite as written, and are even more definite as amended. As described in the M.P.E.P.,

Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of a particular application disclosure;
- (B) The teachings of the prior art;
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

M.P.E.P. § 2173.02. Applicants' specification contains 37 pages of general instruction on how to perform the processes of the claimed invention. The specification also contains 15 pages of non-limiting examples illustrating those processes. While the prior art does not teach the claimed processes, it does teach synthetic manipulations useful

in the claimed processes, and citations to published information<sup>1</sup> can be found throughout Applicants' specification. Finally, one possessing the ordinary level of skill in the art, say, a synthetic organic chemist, should obtain a definite idea of the metes and bounds of the claimed invention from Applicants' chosen language. For example, "converting a compound of the formula II into a compound of the formula III or its salt with an acid HX" (claim 1) amply communicates the starting point and ending point of that particular manipulation. And, "said converting comprises catalytic hydrogenation" and "conversion of the cyano group into an amidino group" communicates the non-sequential actions that take the manipulation to the desired ending point.

The Examiner suggests certain language for claim 1, to clarify the converting of a compound of formula II into a compound of formula III. Office Action at pages 2-3. Applicants respectfully decline to adopt the Examiner's suggested claim language in its entirety, however, because the suggestions would unduly narrow the scope of the claimed invention. For example, the proposed steps (a) and (b) appearing in the Office Action require first hydrogenating the olefinic group, and second, reacting the cyano group. Applicants do not intend to require this sequence. On pages 15 and 16 of their specification, Applicants make clear that the recited steps may occur in either order. See specification at page 15, line 20, to page 16, line 7.

Applicants respectfully submit that both claims, 1 and 17, as amended, are not indefinite.

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<sup>1</sup> Applicants do not admit that any cited document represents "prior art" under United States law.

Regarding isolation of a final product, Applicants respectfully decline to amend their claims to require an isolation step. If the claims require isolation, then the unscrupulous copycat could manufacture the final product exactly according to Applicants' disclosed methodology, and then derivatize the final product in a trivial manner before isolating the derivative. This trivial derivatization may still literally infringe a claim that recites an isolation step, or it may infringe only under the doctrine of equivalents. In any case, however, Applicants strongly feel that an isolation step need not be added to make the claims definite. Instead, Applicants have amended claims 1, 11, and 17 to recite "to yield [the desired product]." The product, once synthesized, may or may not be isolated in processes falling within the scope of Applicants' claimed invention.

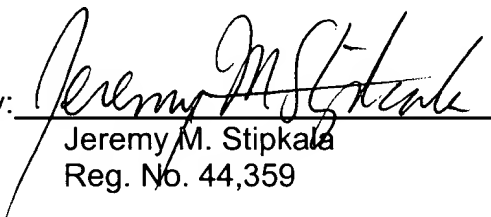
### **CONCLUSION**

A Petition for Extension of Time (Three Months) and fee therefore accompanies this Amendment. Please grant any extensions of time required to enter this Amendment and charge any additional required fees related to this Amendment to our Deposit Account No. 06-0916.

Respectfully submitted,

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